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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,009	02/11/2004	Yun Xu	00216-643001 / T-732	3413
26161	7590	08/01/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			VANIK, DAVID L	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/777,009

Applicant(s)

XU ET AL.

Examiner

David L. Vanik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 14-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10-1-04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of applicant's IDS filed on 10/7/2004. Receipt is also acknowledged of applicant's Oath or Declaration filed on 5/27/2004.

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to a method of shaving, classified in class 424, subclass. 73.
  - II. Claims 14-31, drawn to a composition comprising a cleansing agent, a water soluble polymer, and polytetrafluoroethylene particles, classified in class 424, subclass 401+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used as a personal cleansing composition (See US Patent 5,534,265).

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3. Searching the inventions of Groups I – II together would impose a search burden on the examiner. In the instant case, the search of a composition and a method of using said composition would impose a search burden on the examiner.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for each subset of Groups I – II are not required for one another, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. During a telephone conversation with Celia Leber on 7/25/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation

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of this election must be made by applicant in replying to this Office action. Claims 14-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,587,156 ('156) in view of WO 02/087519 ('519).

'156 teach shaving compositions and methods of using said shaving compositions (abstract). The compositions advanced by '156 comprise a wetting agent, a cleansing agent, and an insoluble particulate additive (claim 1). About 0.1% to about 20% of the insoluble particulate additive can be added to the shaving composition

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(claims 6-7). According to '156, the particulate material can comprise polytetrafluorethylene (claim 8, column 6, lines 37-46). The particulate material can be between 10 – 1000 microns (claims 3-5). The shaving composition may be in the form of a gel or cream (abstract). Based on claims 1-8, it is the examiner's position that the composition is substantially free of anionic polymers.

'156 does not teach a shaving composition comprising a polyethylene oxide and natural or synthetic gum water-soluble polymer.

'519 teach shaving compositions comprising polyethylene oxide and natural or synthetic gum water-soluble polymers (abstract and page 5, lines 2-7). According to '519, the shaving compositions can comprise 0.005 to 10% of the water-soluble polymer and the molecular weight of the polymer can be over a million (abstract and page 5, lines 27-36). If added to the composition set forth by '156, the particulate material and water soluble polymer can be present in a ratio between 0.25:1 to about 3:1.

According to '519, it is beneficial to add polyethylene oxide and natural or synthetic gum water-soluble polymers to a shaving composition because they "interact synergistically to substantially increase the stress ratio of the shaving composition, thereby reducing the coefficient of friction between the cartridge and the razor" (page 5, lines 2-7). This enhances shaving performance (page 1, lines 4-9). Because the addition of polyethylene oxide and natural or synthetic gum water soluble polymers to a shaving cream lotion enhances shaving performance, one of ordinary skill in the art

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would have been motivated to add polyethylene oxide and natural or synthetic gum water soluble polymers to the composition advanced by '156. Based on the teachings of '519, there is a reasonable expectation that the addition of polyethylene oxide and natural or synthetic gum water-soluble polymers to a shaving cream lotion would enhance shaving performance. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add polyethylene oxide and natural or synthetic gum water-soluble polymers to the invention advanced by '156 in view of the teachings of '519.

Claims 1-6, 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication 203/0124083 ('083) in view of WO 02/087519 ('519).

'083 teach a soap-free shaving and moisturizing composition and methods of using said compositions (abstract). According to '083, the shaving composition can comprise water, 3 to 7% of humectants, and between 2 – 7% of polytetrafluorethylene (paragraph 0011). The polytetrafluorethylene can be in the form of micronized beads (paragraph 0010). Said composition can be applied to skin and hair can be shaved off with a razor (abstract). Based on paragraph 0011, it is the examiner's position that the composition is substantially free of anionic polymers.

'083 does not teach a shaving composition comprising a polyethylene oxide and natural or synthetic gum water-soluble polymer.

'519 teach shaving compositions comprising polyethylene oxide and natural or synthetic gum water-soluble polymers (abstract and page 5, lines 2-7). According to '519, the shaving composition can comprise 0.005 to 10% of the water-soluble polymer and the molecular weight of the polymer can be over a million (abstract and page 5, lines 27-36). If added to the composition set forth by '083, the particulate material and water soluble polymer can be present in a ratio between 0.25:1 to about 3:1.

According to '519, it is beneficial to add polyethylene oxide and natural or synthetic gum water-soluble polymers to a shaving composition because they "interact synergistically to substantially increase the stress ratio of the shaving composition, thereby reducing the coefficient of friction between the cartridge and the razor" (page 5, lines 2-7). This enhances shaving performance (page 1, lines 4-9). Because the addition of polyethylene oxide and natural or synthetic gum water soluble polymers to a shaving cream lotion enhances shaving performance, one of ordinary skill in the art would have been motivated to add polyethylene oxide and natural or synthetic gum water soluble polymers to the composition advanced by '083. Based on the teachings of '519, there is a reasonable expectation that the addition of polyethylene oxide and natural or synthetic gum water-soluble polymers to a shaving cream lotion would enhance shaving performance. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add polyethylene oxide and natural or synthetic gum water-soluble polymers to the invention advanced by '083 in view of the teachings of '519.



### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Vanik whose telephone number is (571) 272-3104. The examiner can normally be reached on Monday-Friday 8:30 AM - 5:00 PM.

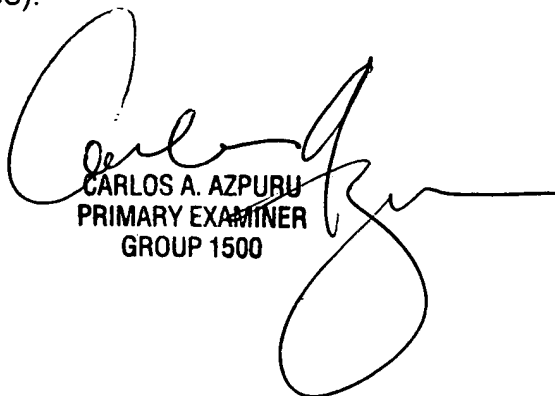
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at (571) 272-0588. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Vanik, Ph.D.  
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7/26/08



CARLOS A. AZPURU  
PRIMARY EXAMINER  
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